

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY ANN D. BROW, VICTOR I. LYAMICHEV and
DAVID M. OLIVE

Appeal No. 2000-0436
Application 08/520,946

MAILED

APR 30 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WILLIAM F. SMITH, SCHEINER, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

REMAND TO THE EXAMINER

The following issues must be addressed before the merits of the examiner's rejection can be reached. We therefore remand this application to the examiner for appropriate action.

1. The Reply Brief

A Reply Brief was filed by Appellants on October 18, 1999, and entered into the file as Paper No. 24. When a Reply Brief is filed, "[t]he primary examiner must either

acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief." 37 CFR § 1.193(b)(1). In this application, the examiner has not responded to the Reply Brief in any way.

Upon return of this application, the examiner must either acknowledge receipt and entry of the reply brief, or reopen prosecution to respond to it.

2. The Brow Declaration

In deciding whether to reopen prosecution, the examiner may wish to consider Appellants' argument that he has not adequately responded to the Brow declaration. See the Reply Brief, pages 6-7. In an admittedly cursory review of the file history, we have found only a single comment by the examiner directed to the Brow declaration:

It is noted that the declaration of Mary Ann D. Brow, filed November 6, 1998 accurately states that Lyamichev et al. taught that a primer was necessary for cleavage of RNA. This is not sufficient to distinguish the instant claims over the prior art because the instant claims recite a *nucleic acid*. Amending the claims to limit the invention to RNA may provide a patentable distinction.

Paper No. 18 (mailed Nov. 23, 1998), page 6 (emphasis in original). This response is repeated verbatim in the Examiner's Answer (pages 13-14).

We remind the examiner that

[w]hen prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over. . . . An earlier decision should not . . . be considered as set in concrete, and applicant's rebuttal evidence then be evaluated only on its knockdown ability. Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened

umbrella effect. Prima facie obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself. Though the tribunal must begin anew, a final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached . . . upon a different record.

In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). See also In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986) ("If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed.").

Thus, rebuttal evidence in the form of a Rule 132 declaration must be considered, along with the evidence tending to show obviousness, in determining whether the record evidence as a whole supports a conclusion of obviousness under § 103. In light of Appellants' argument, the examiner may wish to consider whether he has adequately considered and responded to the Brow declaration.

3. Future Proceedings in this Application

We are not authorizing entry of a Supplemental Examiner's Answer. If the examiner decides that the basis of the rejection requires clarification, or that a further response to Appellants' rebuttal evidence is required, reopening prosecution may be

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necessary. Appellants must be given a full and fair opportunity to respond to any ground of rejection in a future communication.

REMANDED

William F. Smith

William F. Smith
Administrative Patent Judge

Toni R. Scheiner

Toni R. Scheiner
Administrative Patent Judge

Eric Gimes

Eric Gimes,
Administrative Patent Judge

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